

REMARKS

Claims 21 and 29 – 40 are pending by way of the present amendment. Claims 21 and 29 – 33 and 35 are amended and Claims 36 – 40 are newly added. Claim 19 is canceled without prejudice or disclaimer to the underlining subject matter. Support for the amended and newly added claims may be found in the originally presented claims and Specification, for example, in the Specification at page 76, line 5 – page 77, line 4; page 87, line 1 – page 108, line 16; and Table 22. Regarding the specific ratios of compounds (a) and (b) set forth in newly added Claims 36 – 39, support may be found in Examples A – O and Tables A – O spanning pages 87 – 108 of the Specification. Regarding the specific ratios of compounds (a) and (b) set forth in newly added Claim 40, support may be found in Table 22 of the Specification. Entry and consideration of the claim amendments and newly added claims is respectfully requested.

I. Rejection under 35 U.S.C. 103

Claims 19, 21, 25, and 30-35 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over WO 03/010149 (“the ‘149 patent”), published in German. Applicants note that the U.S. counterpart of WO 03/010149 is U.S. Patent 7,538,073 (“the ‘073 patent”). Applicants disagree with the Examiner’s rejection, but have amended the claims solely in order to facilitate prosecution. Accordingly, the Examiner’s claim rejections are rendered moot and withdrawal is respectfully requested.

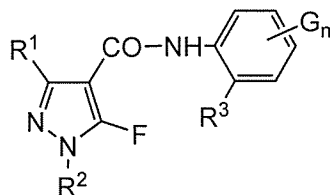
A. The ‘073 patent fails to teach or suggest synergistic combinations of the claimed compounds (a) and (b)

The ‘073 patent fails to teach or suggest the claims. Specifically, the ‘073 patent fails to teach or suggest synergistic combinations of the claimed (a) carboxamide of formula (I-2) together with a compound of (b). Given the teachings of the ‘073 patent, one of ordinary skill in the art would have no motivation to:

- (1) Select the claimed carboxamide of formula (I-2) (compound "a") from the numerous possible compounds listed in the '073 patent;
- (2) Select a compound "b" as claimed;
- (3) Select a claimed combination of compound "a" and compound "b";
- (4) Select a claimed combination of compound "a" and compound "b" in the claimed ratios.

Additionally, the Examiner provides no reason as to why one of ordinary skill in the art would modify the '073 patent in a manner that would render the claims obvious by combining compounds (a) and (b) with a reasonable expectation that such a combination would yield synergistic combination.

The '073 patent is directed to pyrazolylcarboxanilides having the formula



in which the various substituents are defined in the '073 patent at column 1, lines 25-67. The '073 patent teaches compositions containing penflufen (compound 3.26). The '073 patent at column 34. As the Examiner points out, the disclosed pyrazolylcarboxanilides can be used in combination with other active compounds. The '073 patent at column 21, line 61 – column 26, line 15. As stated in the Response dated September 28, 2010, although the '073 patent teaches that "[i]n many cases, synergistic effects are obtained," the reference does not teach or suggest that the claimed mixtures exhibit synergistic properties. The '073 patent at column 21, lines 65-66. Given this, one of ordinary skill in the art would have no reason to expect that the claimed combinations of compound (a) and compound (b) would exhibit synergy.

For at least the above, Applicants respectfully request withdrawal of the 35U.S.C. 103(a) rejection.

B. The '073 patent fails to teach or suggest synergistic combinations of the claimed compounds (a) and (b) in the claimed ratios

Regarding Claims 36 – 40, the '073 patent fails to teach or suggest the synergistic combinations of compounds (a) and (b) in the claimed ratios. Rather, the '073 patent teaches that "[t]he active compounds according to the invention can be used as such or in their formulations, also in a mixture with known fungicides, bactericides, acaricides, nematocides or insecticides, to broaden, for example, the activity spectrum or to prevent development of resistance." The '073 patent at column 21, lines 61 – 65. However, the claimed combinations of compounds (a) and (b) in the claimed ratios are not suggested by the '073 patent. Additionally, the Examiner has provided no evidence as to why one of ordinary skill in the art would have any motivation to alter the '073 patent in a manner that would render the claims obvious.

For at least the above, Applicants respectfully request withdrawal of the 35U.S.C. 103(a) rejection.

C. The Specification provides for unexpected results

In maintaining the claim rejections, the Examiner asserts that "the examples employed specific active agents, at specified amount and specified ratios on specific fungal infections, either as a treatment or pre-treatment, on specific plants." Final Office Action at page 1. The Examiner further asserts that "the evidence provided is not commensurate in scope with the claims." *Id.* at page 5. Applicants disagree.

Claim 21 is amended to recite the exemplified compounds. Examples A – O (and Tables A – O) spanning pages 87 – 108 of the Specification provide evidence of synergism between the claimed compound combinations. Additionally, Examples A - O provides representative ratios between compounds (a) and (b). Given this, one of ordinary skill in the art would recognize that the claimed compound combinations of (a) and (b) exhibit unexpected synergistic efficacy relative to the calculated efficacy alone. By providing representative ratios of compounds (a) and (b), the experimental evidence provided in the Specification is commensurate in scope with the claims and provides further evidence of patentability over the cited reference.

For at least the above, Applicants respectfully request withdrawal of the 35U.S.C. 103(a) rejection.

II. Obvious-type Double Patenting Rejections

A. U.S. Patent 7,538,073 in view of Eicken '070, Eicken '897, and Ding

Claims 19, 21, 25, and 30 – 35 stand rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over Claims 1 – 12 and 14 – 16 of U.S. Patent 7,538,073 in view of U.S. Patent 5,438,070 (“Eicken ‘070”), “Applicant’s admission,” U.S. Patent 5,480,897 (“Eicken ‘897”), and U.S. Patent Publication 2002/0134012 (“Ding”). As stated above, Applicants note that the U.S. counterpart of WO 03/010149 is U.S. Patent 7,538,073 (“the ‘073 patent”). Applicants respectfully disagree with the Examiner's obvious-type double patenting rejections, but have amended the claims solely in order to facilitate prosecution. Accordingly, the Examiner's claim rejections are rendered moot and withdrawal is respectfully requested.

In rejecting the claims, the Examiner asserts that “[t]he difference between the claims of U.S. Patent No. 7,538,073 and the claimed invention is that claims of said US patent do not expressly disclose combining synergistically with other fungicides and treatment of plants, seeds, including transgenic plants and seeds.” Final Office Action at page 9. In addressing this, the Examiner cites to Eicken and states that this reference “discloses the synergistic combination of similarly structured carboxanilides with other fungicides in the treatment of plants...and Din et al. (US Pat. Pub. 2002/0134012) discloses that transgenic seeds can be treated and that this reduces the total amount of pesticides used during the planting and growing of the crop” *Id.*

As acknowledged by the Examiner, Claims 1 – 16 of the '073 patent fail to teach or suggest the claimed synergistic combination of compounds (a) and (b). None of Eicken ‘070, Eicken ‘897, or Ding remedy the deficiencies of the '073 patent and teach or suggest the claimed combinations of compounds (a) and (b). Specifically, none of Eicken ‘070, Eicken ‘897, or Ding teach or suggest a compound of Formula I (compound “a”), let alone the claimed compound of Formula I in combination with the claimed compounds of (b). Additionally, none of the cited references alone, or in combination, teach or suggest the claimed combinations of compounds (a) and (b) as described in Claims 36 – 40.

For at least the above, Applicants respectfully request withdrawal of the 35U.S.C. 103(a) rejection.

B. Rejection over Copending Application 11/997,079

Claims 19, 21, 25, and 30-35 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over Claims 1, 4, and 5 – 15 of copending U.S. Patent Application 11/997,079. Applicants respectfully disagree. However, because this is a provisional rejection, Applicants request that the Examiner hold the obvious-type double patenting rejections in abeyance until such a time that there is an indication of allowable subject matter. *See* MPEP §822.01.

Conclusion

In view of the remarks above, Applicants respectfully submit that this application is in condition for allowance and request favorable action thereon. The Examiner is invited to contact the undersigned if any additional information is required.

Applicants authorize the Commissioner to charge Deposit Account No. 50-4254, referencing Attorney Docket No. 2903925-305000 for fees due or any deficiencies of fees and to credit any overpayments.

Dated: May 18, 2011

Respectfully submitted,

Customer No. 84331

920 Massachusetts Ave., NW
Suite 900
Washington, DC 20001
(202) 508-3400
(202) 508-3488 (Fax)

By /David L. Vanik /
David L. Vanik
Registration No.: 64,547

David W. Woodward
Registration No.: 35,020

BAKER DONELSON BEARMAN CALDWELL &
BERKOWITZ, PC
Attorneys for Applicant